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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,786	12/11/2000	Yasushi Ichikawa	Q62216	2733

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SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3202

EXAMINER

DUONG, THANH P

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/04/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/732,786

Applicant(s)

ICHIKAWA ET AL.

Examiner

Tom P Duong

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-2, 5-7, and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Sullivan (5,779,561). Sullivan discloses a golf ball composition comprising the inner cover layer blended with at least one part (Col. 7, lines 61-63) of 20 mesh (micron) silicone fillers (Col. 9, lines 9-20) in coupling agents or silanes resin (Col. 8, lines 26-31) and blended with resins (Col. 11, lines 1-20).
2. Claims 1-3, 5-12 are rejected under 35 U.S.C. 102(a)<sup>(e)</sup> as being anticipated by Sullivan (6,204,331). Sullivan discloses a golf ball composition comprising interior layers blended with at least one part (Table 11) of finely divided silicone fillers, coated with primers such as silicate esters, silicone pastes, silicone resins or reactive silanes (See Col. 29, lines 15-18 and Abstract), with “dimethyl” functional group (Col. 21, lines 58-60), and ionomeric resin (Col. 2, lines 1-5 and Col. 3, lines 50-52) with Shore D hardness (Table 1) of 66-68.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan '331 in view of Ueshima et al. (5,502,095). Regarding claims 3 and 4, Sullivan '331 does not disclose expressly the type of silicone in the claimed invention. Ueshima et al. discloses the thermoplastic elastomer composition consist of component (C), polyorganosiloxane. Polyorganosiloxane is blended with resin or rubber or filler such as a silicone rubber powder. (Col. 6, line 61-65). Ueshima further teaches that this blended composition can be used as an elemental material for sport and leisure goods (e.g. golf club grip, baseball ball bat grip, swimming and etc.) and other rubber contacts. Regarding claim 4, Official Notice is taken that such specific type of silicone is commercially available and it would have been obvious to use the claimed invention silicone here to improve hardness and durability. Furthermore, Applicant has not disclosed the advantage and/or criticality of using the siloxane having such functional group; thus, it appears the material selection is a matter of design choice at least thru routine optimization. Thus, it would have been obvious in view of Ueshima and Official Notice to one having ordinary skill in the art for Sullivan to select the silicone as taught

by Ueshima and Official Notice in order to provide a golf ball with improved durability, hardness, resilience, and flight distance.

### ***Double Patenting***

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/318,260. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims substantially the same subject matter as the claim invention except specific type of silicone and particle size; however, it would have been obvious for the copending application to select any commercially available silicone grade to provide a golf ball with improved hardness, resilience, and molding.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/318,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims substantially the same subject matter as the claim invention except specific type of silicone and particle size; however, it would have been obvious for the copending

application to select any commercially available silicone grade to provide a golf ball with improved hardness, resilience, and molding.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/318,010. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims substantially the same subject matter as the claim invention except specific type of silicone; however, it would have been obvious for the copending application to select any commercially available silicone grade to provide a golf ball with improved hardness, resilience, and molding.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 10/318,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims substantially the same subject matter as the claim invention except specific type of silicone; however, it would have been obvious for the copending application to select

any commercially available silicone grade to provide a golf ball with improved hardness, resilience, and molding.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/317,985. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims substantially the same subject matter as the claim invention except specific type of silicone; however, it would have been obvious for the copending application to select any commercially available silicone grade to provide a golf ball with improved hardness, resilience, and molding.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.


**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom P Duong whose telephone number is (703) 305-4559. The examiner can normally be reached on 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on (703) 308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 873-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Tom Duong  
September 2, 2003

  
Paul T. Sewell  
Supervisory Patent Examiner  
Group 3700